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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,112	06/14/2001	Frederick F. Becker	UTXC:626US/MCB	7970

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EXAMINER	
DO, PENSEE T	

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/883,112	BECKER ET AL.	
	Examiner	Art Unit	
	Pensee T. Do	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 24-41* is/are pending in the application.

4a) Of the above claim(s) *1-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-34,36-39 and 41* is/are rejected.

7)☒ Claim(s) *35 and 40* is/are objected to.

8)☒ Claim(s) *1-18 and 24-41* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejection(s)

Rejections under 102 and 103 sections in the previous office action are withdrawn.

Amendment Entry and Claim Status

The amendment filed on March 3, 2003 has been acknowledged and entered.

Claims 1-18 are withdrawn from further consideration.

Claims 19-23 are cancelled.

Claims 24-41 are being examined.

New Ground(s) of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24, line 6, lacks antecedent support for "the target analyte".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

> applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-31, 33, 34 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Xu et al. (US 6,858,439).

Xu teaches a method of dielectrophoretic separation of one or more moieties in a sample. The method comprises adding to the sample a solution that modifies at least one dielectric property of one or more components of the sample and has a conductivity such that one or more moieties of the sample can be separated using dielectrophoresis. Such solutions can be used in the analysis of samples on chips, and can be used in methods that use binding partners, including microparticles that can be translocated by dielectrophoretic forces, traveling wave dielectrophoretic forces or magnetic forces. Binding partners such as microparticles bound to a binder for the target analyte are added to the sample after, before or at the same time as the sample solution. Manipulation (including isolation) of moieties in the sample in a chamber can occur through the application of a non-uniform AC electric field and one or more power sources or electrical signal generators, which may be capable of varying voltage, frequency, phase etc. (see col. 31, lines 10-55). The frequency of the separation of moieties depends on a dielectric property of the moieties to be separated and the conductivity of the solution of the moieties is suspended in. The dielectric separation of cells can also be monitored by loading cells with detectable labels such as dyes. (see col. 26, lines 35-38). Separation of moieties by dielectrophoretic forces can occur by any dielectrophoretic mechanism (DEP), for example by DEP retention, DEP migration,

DEP/gravitational field flow fractionation, or traveling wave DEP-based separation or 2-D DEP. (see col. 31, lines 55-66). The microparticle is a structure of any shape and of any composition that is manipulatable by desired physical forces. The microparticles can be comprised of any suitable material, such as glass, ceramics and/or one or more polymers such as nylon, polytetrafluoroethylene (TEFLON), polystyrene, polyacrylamide, sepharose, agarose, cellulose, or dextran and/or can comprise metals. Examples of microparticles are plastic particles, ceramic particles, magnetic beads, hollow glass spheres, metal particles, particle of complex composition such as particles that comprise of multiple compositional elements, for example metallic sphere covered with a thin layer of non-conducting polymer film (equivalent to the microparticle having a conductive core (metallic is conductive) with an insulating layer coating). Microparticles should have appropriate dielectric properties such that they can be manipulated by the dielectrophoretic force. (see col. 28, lines 4-22). The moiety to be manipulated can be coupled to the surface of the particles through a linker. Linkages such as antigen-antibody; ligand-receptor interaction or biotin-streptavidin interaction are appropriate. (see col. 29, lines 1-13). More than one moieties of a sample can be separated. (see col. 27, lines 4-15). Microparticles with different binding partners can be prepared to separate more than one moieties of a sample. Such microparticles must inherently have different dielectric properties. Application of a non-uniform AC electric field results in retention of the target analyte coupled to microparticles at electrode surfaces. (see col. 32, lines 60-65). For separation of moiety of interest from a mixture of sample components by dielectrophoretic manipulation, the binding partner's dielectric properties

should be significantly different from those of other sample components so that when the microparticles are coupled to the moiety of interest, the moiety of interest-binding partner complex can be selectively manipulated using dielectrophoresis. Distinguishing between the dielectric properties must be inherently achieved in order to isolate the different moieties of interest. (see col. 28, lines 25-33). The sample comprises blood or cell and can be from any source such as an organism, from environment, such as a body of water or from the soil, or from a food source or an industrial source. A sample can be unprocessed or processed, a gas, a liquid or a semi-solid and a solution or a suspension, an extract. (see col. 10, line 7-col. 11, line 3). Manipulation refers to sorting or separating, trapping, isolation, which is the same as purification. (see col. 9, lines 35-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 24-31, 33-34, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ewart et al. (US 5,922,537) in view of Parton et al. (US 5,653,859).

Ewart teaches an assay method, sandwich, indirect, competitive or direct assay, using reporter particles such as dielectric particles (see col. 4, lines 6-14). The core particles can be made from a wide variety of inorganic materials including metals such as gold, silver, platinium (see col. 5, lines 17-26). The particle core can be encapsulated

in a polymer such as polystyrene (see col. 7, lines 20-30). The dielectric particles can be engineered to have one or more dielectric properties or paramagnetic properties and phosphorescent properties (see col. 11, lines 7-13). In the assay, the target analyte is contacted with the reporter particles linked to a recognition molecule that specifically binds the target analyte. Detection is performed by comparison of the dielectric constant of unbound dielectric particles/labels and that of the complexed dielectric particles/labels using a biosensor to measure those properties. (see col. 4, lines 53-65). The dielectric particles/labels contributes the dominant dielectric constant (second dielectric property) in the complex analyte-recognition molecule-dielectric label (see col. 14, lines 33-38). The dielectric property of an unbound dielectric label is the first dielectric property. The recognition molecule/linking element comprises of antibody, hormone, antigen, etc. (see col. 7, lines 54-65). The sample is bodily fluid such as blood (see col. 4, lines 49-51). Ewart also teaches that the dielectric particles/labels move in an electrophoretic field when being applied in a separation method (see col. 11, lines 27-31). Trapping is performed when the particles captures the analyte. Sorting is the same as separating and purification.

However, Ewart fails to teach manipulation by dielectrophoresis; a method wherein the sample comprises water, food, food processing, food distribution, mineral, or ore; adding to the sample a plurality of engineered microparticles in a method of identifying one or more complexes within a sample; identifying one or more complexes by distinguishing between the different dielectric properties using one ore more impedance sensors; admixing with the sample an engineered microparticle having a

first dielectric property; associating the engineered particle with a target analyte to form a complex having a second dielectric property and detecting the complex by distinguishing between the first and second dielectric properties using one or more impedance sensors.

Parton teaches a method wherein a microparticle including an oligonucleotide or synthetic oligonucleotide analogue as a capture probe (linking moiety) bound to the surface of a polymer bead and having a sequence complementary to that of an expected amplification procedure product. A label comprising a traveling wave field migration (TWFW) labeling moiety bound to a second oligonucleotide or oligonucleotide analogue sequence complementary to the second region of the ligand nucleic acid sequence is employed. The microparticles and the label may be added to the product of the amplification reaction before or after any working up of the reaction mixture to separate the amplification products. The TWFM properties (second dielectric property) of the microparticle/amplification product/label ternary complex may then be observed and distinguished from those of the microparticles alone on the basis of different dielectric properties. The microparticle alone having a first dielectric property. If the oligonucleotides/target ligands are labeled with a "dielectric" marker, they can be separated on the basis of their dielectric properties. This may be achieved by using different migration frequencies, or selective electrode arrays. (see col. 9, line 25-col. 10 line 15; fig. 11, 1-3). The traveling wave field migration is the same as traveling wave dielectrophoresis. (see col. 2, lines 9-12). The label dielectric particles may comprise a second linking moiety carried by the label. The label is a fluorophore, a chromaphore or

a micro-organism, a metal particle, a polymer bead or a magnetic particle. For use in connection with TWFM measurements, the label has dielectric properties and is capable of acquiring a significant surface charge. A preferred material is colloidal gold, which is easily bound to antibodies to form a label. (see col. 3, lines 34-60). The target analyte may be a toxin present as a contaminant in a foodstuff. (see col. 8, lines 56-57). Detection is by electrical impedance, capacitance or inductance (see col. 8, lines 6-20).

It would have been obvious to one of ordinary skills in the art to use dielectrophoresis force or TWFM to separate target ligands as taught by Parton in the method of Ewart since these two references teach a separation method using dielectric particles as labels. Since Ewart teaches using particles with dielectric properties, it would have been obvious to use dielectrophoresis to separate these particles as taught by Parton because dielectrophoretic separation provides an efficient, reliable, nondisruptive, and automatable method for the separation of moieties in a sample based on their dielectric properties. Regarding claim 26, the sample comprising of food, water, food processing etc, since Ewart teaches, in col. 1, lines 32-35, that detection of analyte in a sample may be indicative of a particular condition in microorganism and higher life forms including animals and humans, one of ordinary skills in the art would find it obvious to detect analytes such as toxin from foodstuff taught by Parton or analytes from a variety of sample sources such as food, water because food and water contain microorganisms and food such as meat products are sources from animals. It would have been obvious to one of ordinary skills in the art to use the engineered particles of Ewart in a plurality for detecting one or more complexes within one sample

which is economically advantageous because time and effort can be saved and mass detection/sorting/separation can be performed all in one batch. It would also have been obvious to one of ordinary skills in the art to use the impedance sensors as a detection means taught by Parton in the method of Ewart for detecting different dielectrophoretic properties of the particles since impedance sensors is means for distinguishing the different dielectric properties of the particles.

Response to Arguments

Applicant's arguments with respect to claims 24-31, 33, 34, 36-39, 41 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 35 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 32 is free of prior arts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
May 11, 2005

Christopher L. Chin

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5/12/05